

Patent Application No. 10/606,260
Amendment dated January 18, 2007
Reply to Office Action of May 18, 2006

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REMARKS

The Applicants thank the Examiner for the consideration shown the present application thus far. Claims 5-14 are pending and stand rejected. Claims 5 and 12 have been amended. Support for the present amendment can be found in Figure 1 and pages 3-8 for both claims 5 and 12. Additional support can be found at pages 9-15 for claim 5 and pages 15-16 for claim 12.

35 U.S.C. § 112 Rejections

Claims 5-14 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

The Examiner states that the previous amendments to claims 5 and 12 were unsupported by the present specification. Without addressing the Examiner's individual concerns, the previous amendments have been canceled and new amendments have been entered. There is ample support for the present amendment as is discussed above. In light of the present amendment, Applicants respectfully request reconsideration and allowance of Claims 5-14 over the Examiner's 35 U.S.C. § 112, first and second paragraph, rejections.

35 U.S.C. § 103 Rejection over Schroeder

Claims 5-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schroeder, et al. (U.S. Patent No. 4,272,554, Herein after "Schroeder"). The Applicants respectfully traverse this rejection.

By the present amendment, asparagine within the snack chip must be "reduced" in amount. By reducing the amount of asparagine present, there is less asparagine present that can be later converted to acrylamide. In stark contrast, the addition of calcium to a potato based dough, as taught in Schroeder, does not reduce the amount of asparagine. Rather the divalent cation (for example, calcium) complexes with the asparagine, and/or the reaction product of asparagine and reducing sugars, rendering it unavailable for conversion to acrylamide. But the asparagine or its reaction products are still present. See, for example, US2005/0079254 A1, to Corrigan, paragraph [0017]. Thus, the present claims are directed to an entirely different chemical processes than that taught in Schroeder. Accordingly, Schroeder does not teach or suggest the reduction of acrylamide in a snack chip as claimed herein. As such, Schroeder does not teach or suggest the limitations of the present claims. It is respectfully requested that the present rejection of claims 5-9 under 35 USC § 103 over Schroeder be withdrawn.

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35 U.S.C. § 103 Rejection over Elder

Claims 5-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elder, et al. (U.S. Patent Application No. 2004/0058054—hereinafter, Elder). The Applicants respectfully traverse this rejection.

The Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fe. Cir. 1983). If the Examiner does not prove a prima facie case of unpatentability, then without more, the Applicant is entitled to grant of the patent. See *In re Oetiker*, 977 F.2d 1443.

To establish a prima facie case of obviousness under 35 U.S.C. § 103, the Examiner must meet three basic criteria. First there must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. And finally, the prior art reference (or references when combined) must teach all of the claim limitations. See, for example, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicants respectfully assert that the references cited in the Office Action fail to teach all claim limitations, and thus, fail to establish a prima facie case of obviousness under 35 U.S.C. § 103.

The Examiner has failed to establish a prima facie case of obviousness because Elder does not teach or suggest an article of commerce that includes a snack chip or a French fry in a container with message that the product within the container contains lower levels of acrylamide than does a comparable untreated chip or fry. The Examiner does not assert that Elder teaches all the limitations of the present claims. Instead, the claim language relating to the container and message is given no patentable weight. The Applicants respectfully disagree that the claim limitations should be given no weight.

Specifically, in *In re Miller*, 164 USPQ 46 (CCPA 1969) and *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), articles comprising previously known compositions, in association with information which was functionally related to such composition, were held novel and non-obvious over the known compositions. For example, in *Miller*, which related to printed information on a measuring device, the Court stated:

[The Examiner's] characterization of printed matter as "unpatentable" is beside the point; no attempt is here being made to patent printed matter as such. The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon . . . and a legend indicating the ratio, and in our judgment the appealed claims properly define this relationship.

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See Miller, at third paragraph from conclusion of opinion.

The Federal Circuit affirmed this holding in *Gulack*, even while recognizing that the “sole difference” between the claimed article and the prior art composition was the printed material. In *Gulack*, the Federal Circuit stated:

A functional relationship of the precise type found by the CCPA in *Miller* – to size or to type of substrate, or conveying information about [the] substrate – is not required. What is required is the existence of differences between the appealed claims and the prior art sufficient to establish patentability.

See Gulack, Section II, B.

Neither *Miller* nor *Gulack* have been overturned by the Court of Appeals for the Federal Circuit. As such, it is believed that the message on the container of the present claims, which tells the consumer that the snack chip or French fry within the container has a reduced level of acrylamide, has a functional relationship to the treated product within the container. Thus, under current CAFC case law, all of the limitations of the present claims should be given patentable weight. And because *Elder* does not teach or suggest these limitations, the present claims are not obvious over the disclosure of *Elder*. It is therefore, respectfully requested that the present rejection under 35 USC 103 over *Elder* be withdrawn.

Double Patenting - Non-Statutory

Claims 5-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of co-pending Application No. 10/606,260. This rejection appears to be in error as the serial number in the office action is the same as the serial number for the present case.

Claims 5-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 13-14 of co-pending Application No. 10/603,978. The '978 application is commonly owned and generally related to the present application. Should the present claims be allowed before those in the '978 application then a Terminal Disclaimer will be filed.

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Conclusion

It is believed that the rejections of the present claims have all been addressed and overcome. As such, it is respectfully requested that the rejections under 35 USC §§ 112 and 103 be withdrawn and a prompt notice of allowability be issued.

Respectfully submitted,

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